



Dkt. 45113/RDK

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Applicants : KAST, Wybe Martin et al.  
U.S. Serial No. : 08/170,344  
U.S. Filing Date : March 30, 1994  
For : PEPTIDES OF HUMAN PAPILLOMA VIRUS FOR USE IN  
HUMAN T CELL RESPONSE INDUCING  
COMPOSITIONS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF THOMAS F. MORAN, ESQ.**

I, Thomas F. Moran, hereby declare as follows:

1. I am a retired attorney-at-law admitted to practice in the State of New York, and before the United States Patent & Trademark Office (Registration No. 16,579). I am a former partner at Cooper & Dunham LLP, 1185 Avenue of the Americas, New York, NY 10036. I make this declaration in support of the petition to revive the above-identified application or to suspend the rules. All statements made herein are based upon personal knowledge, except where stated to be on information and belief.

2. I filed U.S. Patent Application Serial No. 08/170,344 on March 30, 1994. At that time, I was in the process of retiring from the practice of law. I was asked by the partners in the firm to begin turning over responsibility for my remaining clients and matters to other partners in the firm. I asked Mr. Robert Katz, a partner at Cooper & Dunham, to assume representation of Vereenigde Octrooibureaux, a European Patent firm located in The Hague, The Netherlands, who had retained me to file and

prosecute U.S. applications on behalf of its European clients.

3. I collected the files for existing matters and requested Mr. Katz to handle them going forward. Apparently, however, this application file never got turned over by me. I was unaware that this file had not been turned over when I formally retired from the firm in November, 1996.

4. As of October 30, 1994, Cooper & Dunham moved its offices from 30 Rockefeller Plaza, New York, New York to 1185 Avenue of the Americas, New York, New York. A mail forwarding request was filed by the firm with the U.S. Postal Service, and mail was forwarded for at least a year. Each partner or other attorney in the firm was asked to notify his or her clients, as well as the U.S. Patent & Trademark Office (PTO) about the address change on matters for which he or she was responsible so that mail would be directed to the proper address. I tried to notify the PTO about the change of address for each of my clients and matters.

5. I am informed that Mr. Katz did not locate a change of address form for this matter sent to the PTO at any time after 1994. I note that when I wrote to the PTO, I used the proper address on correspondence. I do not recall specifically for this application whether I notified the PTO of the change of address. As a result, PTO correspondence for this application continued to be sent to the 30 Rockefeller Plaza address.

6. On information and belief, the mail forwarding request that the firm filed expired sometime in 1995 or 1996. The first Office Action for this application was mailed on August 23, 1995 and was received on August 28, 1995. The address thereon was 30 Rockefeller Plaza, so it was apparently forwarded by the Post Office to the firm's new address. I filed a response to this Office Action on February 23, 1996. The return postcard supplied by the firm had printed thereon the new address,

and was mailed with the response to the Office Action. It was stamped by the PTO as received and received back by our docketing clerk on March 13, 1996. A copy of the postcard is attached to Mr. Katz's declaration.

7. Thereafter, no mail was received for this docket. More particularly, I did not receive the Office Action dated June 14, 1996, nor the Notice of Abandonment dated January 23, 1997. I was unaware that these items had been mailed to the firm.

8. On information and belief, I understand that many Examiners in the PTO have a practice of calling attorneys of record to see whether the failure to respond to an Office Action was intentional or unintentional. I have no recollection of receiving a telephone call concerning this application. I do not have phone message records from that time, and do not believe they exist. A copy of a phone message would most likely be in the file, if I had received one. I understand that no such message was located.

9. As of my retirement in November 1996, I was unaware that an Office Action had been sent to 30 Rockefeller Plaza by the PTO in June 1996. Any PTO mail received by the firm for one of my former clients after I had retired would have been forwarded and handled by the successor attorney.

10. I had no intention to abandon this application at any time from June, 1996 to the present, and never received instructions from Vereenidge or anyone else to abandon this application. I was likewise unaware that PTO communications for this matter were still being mailed to our former address at 30 Rockefeller Plaza. Thus, the entire delay in filing a response from June, 1996 when the Office Action was mailed, until the date of the present declaration was unintentional.

11. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

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statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: August 18, 2004

Thomas F. Moran  
Thomas F. Moran